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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/719,629	11/21/2003	Derek Raybould	H0003891-1170	3479

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EXAMINER

MILLER, DANIEL H

ART UNIT	PAPER NUMBER
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1775

DATE MAILED: 03/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/719,629	Applicant(s) RAYBOULD ET AL.	
	Examiner Daniel Miller	Art Unit 1775	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-71 is/are pending in the application.
 4a) Of the above claim(s) 36-71 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☒ Claim(s) 14,20 and 27 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/21/03</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-35, drawn to an Si based layered article, classified in class 428, subclass 408.
 - II. Claims 36-66, drawn to a method of manufacturing a Si based layered article, classified in class 428, subclass 430.1.
 - III. Claims 67-71, drawn to a composition, classified in class 501, subclass 152.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions of group I and group II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product can be made from a materially different process. For instance, the coating may be formed without the use of sintering and the environmental layer may comprise a material that does not react to form $\text{Si}(\text{OH})_4$.
3. Inventions group I and group III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant

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case, the different inventions are unrelated because the composition can be used in applications unrelated to the article.

4. Inventions group II and group III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the different inventions are unrelated because the composition can be used in applications unrelated to the article.

5. Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

6. During a telephone conversation with the attorney of record on 2/7/06 a provisional election was made with traverse to prosecute the invention of group I, claims 1-35. Affirmation of this election must be made by applicant in replying to this Office action. Claims 36-71 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

8.

Claim Rejections - 35 USC § 112

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

11. Should “and” be “or” in line 3?

Claim Objections

12. Claim 8 is objected to because of the following informalities: What is Zirconia oxide? Zirconia is an oxide already. Appropriate correction is required.

Claim Rejections - 35 USC § 102

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

14. Claims 1, 3, 4, 6, 8-10, 17, 21 and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Lee (U.S. 6,759,151).

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15. Lee teaches a protective coating system used to cover a Si-based substrate in a turbine engine (column 2 line 55-60).

16. Regarding claims 1 and 10, the reference teaches a Si based substrate. The silicon substrate is SiC (diffusion barrier) or can comprises a SiN₄ in a liner form (figure 5). Regarding claim 1, Lee teaches an oxygen barrier layer formed from mullite and then an environmental barrier comprising metallic disilicate (BSAS figure 3a and 4b), followed by a thermal barrier or second environmental barrier of (HfTaO₄). All of which would inherently function as claimed by applicant.

17. Regarding claim 10 and 17, Lee also teaches an oxygen barrier layer that comprising metallic disilicate (BSAS figure 4b), and an environmental barrier coating (see figure 4b) comprising HfTaO₄ (which is a tantalum oxide alloy, see figure 4b). Regarding claim 22, the reference teaches the diffusion barrier, an oxidation barrier and an environmental barrier, as stated above. Further, there is a topcoat (thermal barrier) that can be (YSZ) (column 1 line 65-68) (also meeting limitations of claim 21).

Claim Rejections - 35 USC § 103

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. Claims 1-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee ('908) in view of Lee (U.S. 6,759,151).

20. Regarding claims 1, 10, 17, and 22, Lee ('908) teaches a protective coating system used to cover a Si-based substrate in a turbine engine (column 1 line 20-30).

21. Regarding claims 1 and 10, Lee ('908) teaches a Si based substrate with an oxygen barrier layer that comprising metallic disilicate (BSAS figure 2 and 6), and an environmental barrier coating. Regarding claims 1, 10 and 17, the surface of the silicon substrate is SiC (diffusion barrier) or can comprise a SiN₄ or silicon oxynitride (column 8 line 17-37). Regarding claim 1, 16, 21 and 22, the topcoat can be a (YSZ) thermal barrier coating (figure 2 and abstract). However the reference is silent as to the composition of intermediate layers or the composition of the environmental barrier.

22. Lee ('151) teaches a protective coating system used to cover a Si-based substrate in a turbine engine (column 2 line 55-60).

23. Lee ('151) further teaches an environmental barrier coating comprising HfTaO₄ (which is a tantalum oxide alloy required by applicant's claims 7, 17, and 22, see figure 4b reference).

24. It would have been obvious to one of ordinary skill in the art to use the layers Lee '151 in the article of Lee '908, as the layers of Lee '151 are Low CTE layers because they provide environmental protection from water and vapor.

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25. Regarding claim 2, both diffusion barriers (the surface of the substrates) can be SiC (diffusion barrier) or comprises a SiN₄ or silicon oxynitride (Lee '908 column 8 line 17-37).

26. Regarding claims 3-4, 11 and 15, the inner layer can be SiON₂ and the outer layer can be RE₂Si₂O₇ where RE is Sc or Yb (column 7 line 60-68 Lee '908).

27. Regarding claim 5, Lee ('908) contemplates an oxide ceramic such as mullite, which would have SiO₂ present on the surface of the substrate and render obvious a SiO₂ layer (diffusion barrier) (column 8 line 30-37).

28. Regarding claims 6, 12, and 19, Lee ('908) teaches that layer (22) comprises at least one of the disilicate mentioned above addressing claims 3-4 and a monosilicate, ReSiO₅ (column 7 line 60-68), and Hafnia a metal oxide.

29. Regarding claim 8, the top coating (thermal barrier) can be (YSZ), which is a zirconium oxide alloyed with a yttrium oxide (figure 2 and abstract Lee '908).

30. Regarding claim 9, Lee ('151) teaches layer 22 increases in concentration of stabilized zirconia as you move to the outer portion of the layer.

31. Regarding claims 13, 18, and 24, Lee ('151) teaches the ceramic substrate can be a Si-containing ceramic, such as silicon oxynitride, or oxide or a CMC composite (column 8 line 23-27). Therefore, it would be obvious to have a silicon oxynitride surface and a silicon nitride core substrate since both are contemplated (column 8 line 20-25). Further, the outer layer is a metallic disilicate (figures 2 and 6).

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32. Regarding claims 23, 24-25, 29-31, and 35, it would have been obvious through routine experimentation to optimize the coating thicknesses to provide the best protective properties.

33. Regarding claim 28, Lee ('908) teaches that layer (22) comprises at least one of the disilicate mentioned above addressing claims 3-4 and a monosilicate, ReSiO_5 (column 7 line 60-68), and Hafnia metal oxide. The reference discloses (figure 2) a (BSAS) coating falling within the claimed range of 60-100%.

34. Regarding claims 32-33, these claims are obvious in view of the reference. When the final product is disclosed either by a single reference or by a combination of references in a product by process claim the process limitations are not indicative of patentability.

35. Regarding claim 34, the surface of the silicon substrate is SiC (diffusion barrier) or can comprises a SiN_4 or silicon oxynitrate (column 8 line 17-37 Lee '151).

Allowable Subject Matter

36. Claims 14, 20, and 27 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

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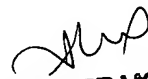
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Miller whose telephone number is (571) 272-1534. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jennifer McNeil can be reached on (571) 272-1540. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Daniel Miller



JENNIFER MCNEIL
PRIMARY EXAMINER
3/6/06